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Solutions, Inc. and Verisk Analytics, Inc.*

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY**

EAGLE VIEW TECHNOLOGIES, INC.
and PICTOMETRY INTERNATIONAL
CORP.,

Plaintiffs,

v.

XACTWARE SOLUTIONS, INC. and
VERISK ANALYTICS, INC.,

Defendants.

Civil Action No. 15-cv-07025-RBK-JS

Motion Date: See D.E. 458

FILED UNDER SEAL

ORAL ARGUMENT REQUESTED

**DEFENDANTS XACTWARE SOLUTIONS, INC.'S AND VERISK
ANALYTICS, INC.'S LOCAL RULE 56.1 STATEMENT OF MATERIAL
FACTS NOT IN DISPUTE IN SUPPORT OF THEIR MOTION FOR
SUMMARY JUDGMENT OF EQUITABLE ESTOPPEL**

Defendants Xactware Solutions, Inc. (“Xactware”) and Verisk Analytics, Inc. (“Verisk”) (collectively, “Defendants”) submit this Statement of Material Facts Not in Dispute pursuant to Rule 56.1 of the Local Civil Rules of the United States District Court for the District of New Jersey.

1. The six currently asserted patents in this case—all owned by Eagle View Technologies, Inc. (“EagleView” or “Plaintiff”)—are U.S. Patent Nos. 8,078,436 (“the ’436 Patent”) (Ex.¹ A), 8,170,840 (“the ’840 Patent”) (Ex. B), 8,818,770 (“the ’770 Patent”) (Ex. C), 8,825,454 (“the ’454 Patent”) (Ex. D), 9,129,376 (“the ’376 Patent”) (Ex. E), and 9,135,737 (“the ’737 Patent”) (Ex. F). (Dkt. 282-1 at 2.)

2. The application for the ’436 Patent was filed on October 16, 2008, the ’436 Patent originally issued on December 13, 2011, and the reexamined claims of the ’436 Patent issued on August 27, 2014. (Ex. A.)

3. The application for the ’840 Patent was filed on May 15, 2009, and the ’840 Patent issued on May 1, 2012. (Ex. B.)

4. The application for the ’770 Patent was filed on April 3, 2012, and the ’770 Patent issued on August 26, 2014. (Ex. C.)

¹ “Ex.” refers to the corresponding exhibit attached to the Declaration of Scott S. Christie, filed concurrently herewith.

5. The application for the '454 Patent was filed on May 17, 2102, and the '454 Patent issued on September 2, 2014. (Ex. D.)

6. The application for the '376 Patent was filed on July 31, 2014, and the '376 Patent issued on September 8, 2015. (Ex. E.)

7. The application for the '737 Patent was filed on August 1, 2014, and the '737 Patent issued on September 15, 2015. (Ex. F.)

8. In addition to the six currently asserted patents, EagleView originally filed suit alleging infringement of three other patents, which have since been dropped from the case: U.S. Patent Nos. 8,209,152 (“the '152 Patent”) (Ex. G), which issued on June 26, 2012; 8,542,880 (“the '880 Patent”) (Ex. H), which issued on September 24, 2013; and 8,823,732 (“the '732 Patent”) (Ex. I), which issued on September 2, 2014. (Exs. G-I.)

9. EagleView also owns non-asserted U.S. Patent No. 8,145,578 (“the '578 Patent”) (Ex. J), which bears a filing date of April 17, 2008 and an issue date of March 27, 2012, and of which the application that lead to the '436 Patent is a continuation-in-part. (Exs. J, A.)

10. Plaintiff has accused “Defendants’ rooftop aerial measurement products, including Xactimate and Aerial Sketch; and Xactimate, Property Insight/Roof InSight, and the ‘Mass Production Tool’” of infringing all of the asserted patents, except the '436 Patent. (Ex. K, Second Amended Disclosure of

Asserted Claims and Infringement Contentions Pursuant to L. Pat. R. 3.1 at 15, 32, 40, 50, 59.)

11. Plaintiff has accused “Defendants’ rooftop aerial measurement products, including Xactimate, Property Insight/Roof InSight, and the ‘Mass Production Tool’” of infringing the ’436 Patent. (Ex. K, Second Amended Disclosure of Asserted Claims and Infringement Contentions Pursuant to L. Pat. R. 3.1 at 6.)

12. Verisk’s subsidiaries, Xactware and Geomni, provide the products accused of infringement. (Ex. L, Fulton Tr. at 24:23-30:11, 166:7-18.)

13. “Xactware is the owner of certain software and licenses and provides computer software solutions that aid contractors and insurance adjusters in estimating repairs,” including Xactimate. (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1 ¶ 13, *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012); Ex. L, Fulton Tr. at 166:7-18.)

14. Asserted Claims 2, 21, and 36 of the ’436 Patent, Claims 10 and 18 of the ’840 Patent, Claim 12 of the ’770 Patent, Claim 26 of the ’454 Patent, Claims 17, 20, and 23 of the ’376 Patent, and Claim 25 of the ’737 Patent (the “asserted claims”) each recite a “roof estimate report,” either in the preamble or the body of the claim. (Ex. A, ’436 Patent, Claims 2, 21, and 36; Ex. B, ’840 Patent, Claims

10 and 18; Ex. C, '770 Patent, Claim 12; Ex. D, '454 Patent, Claim 26; Ex. E, '376 Patent, Claims 17, 20, and 23; Ex. F, '737 Patent, Claim 25.)

15. EagleView, founded in 2008, sells roof reports to roofing contractors and insurance companies. (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1 ¶¶ 9-12, *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012); Ex. N, Pershing Tr. at 91:14-16.)

16. In November 2008, [REDACTED]

[REDACTED] (Ex. O, Barrow Tr. at 52:19-53:23.)

17. Xactware [REDACTED]

[REDACTED] (Ex. P, Lewis Tr. at

104:24-105:8.)

18. Xactware's Aerial Sketch product was first sold in 2011, its Roof InSight product was first sold in 2012, and its Property InSight product was first sold in 2015. (Ex. Q, Xactware's Suppl. Resp. to EagleView's Interrogatory No. 1.)

19. In April 2012, Chris Barrow, then-CEO of EagleView, conveyed to Jim Loveland, then President and CEO of Xactware, that [REDACTED]

[REDACTED]. (Ex. R, Loveland e-mail, XW00395033 at 033.)

20. In early 2008, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Ex. S, Webecke e-mail, XW00238956 at 956.)

21. EagleView sued two other companies, RoofWalk and Aerialogics, for patent infringement. (Ex. T, EagleView's 3rd Suppl. Resp. to Defendants' Interrogatory No. 13 at 6-8; *Eagle View Technologies, Inc. v. Aerialogics, LLC*, No. 2:12-cv-00618 (W.D. Wash.); *Eagle View Technologies, Inc. v. RoofWalk, Inc.*, No. 2:12-cv-00544 (W.D. Wash.).)

22. EagleView sued Xactware in 2012 alleging breach of contract and seeking a temporary restraining order, but not alleging patent infringement. (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1, *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012).)

23. In its suit against Xactware in 2012 in the Western District of Washington, EagleView alleged that, "[w]ithout the ability to import data from or through Xactware's Network ... Eagle View will suffer immediate and irreparable harm." (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1 ¶ 29,

Eagle View Technologies, Inc. v. Xactware Solutions, Inc., No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012).)

24. Also in that 2012 suit against Xactware, EagleView claimed that “[b]ecause the vast majority of insurance-repair contractors and property insurers use Xactware’s network, Eagle View will not be able to secure sufficient business from new customers to replace its lost business.” (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1 ¶ 32, *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012).)

25. In early 2012, Xactware [REDACTED] [REDACTED] (Ex. R, Loveland e-mail, XW00395033 at 033; Ex. N, Pershing Tr. at 30:12-31:6.)

26. As EagleView’s 2012 suit against Xactware proceeded, [REDACTED] [REDACTED] [REDACTED] (Ex. O, Barrow Tr. at 189:6-190:17.)

27. “The relationship between [the] two companies,” EagleView and Xactware, “had a fair amount of friction in it.” (Ex. O, Barrow Tr. at 191:10-17.)

28. On January 14, 2014, Verisk and EagleView Technology Corporation signed an agreement for the acquisition of EagleView by Verisk through a merger transaction (the “January 14, 2014 Agreement”). (Ex. U, Verisk-EagleView Acquisition Agreement, EV00775747 at 752, 846.)

29. The January 14, 2014 Agreement was signed on behalf of EagleView Technology Corporation by its then-CEO, Chris Barrow, and remained in effect pending review by the Federal Trade Commission. (Ex. U, Verisk-EagleView Acquisition Agreement, EV00775747 at 752, 846.)

30. [REDACTED]

[REDACTED]

[REDACTED]

(Ex. U, Verisk-EagleView Acquisition Agreement, EV00775747 at 795.)

31. [REDACTED]

[REDACTED]

[REDACTED]

(Ex. V, Disclosure Schedule of Verisk-EagleView Acquisition Agreement, EV00792365 at 421.)

32. [REDACTED]

[REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED] [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] (Ex. V, Disclosure Schedule of

Verisk-EagleView Acquisition Agreement, EV00792365 at 392-395.)

33. “Eagle View was aware of Xactware marketing products under the name AerialSketch at least as of 2013. Eagle View was aware of Xactware marketing products under the names Roof Insight and Property Insight at least as of January 2014.” (Ex. W, EagleView’s Resp. to Defendants’ Interrogatory No. 1 at 3.)

34. On December 16, 2014, the Federal Trade Commission issued a Complaint, blocking Verisk’s attempted acquisition of EagleView. (Ex X, FTC Complaint, EV00032008.)

35. In its Complaint, the FTC stated, “Post-Acquisition, the combined firm would control close to 99 percent of the relevant market, resulting in a dominant firm with no meaningful competitors.” (Ex X, FTC Complaint ¶ 29, EV00032008.)

36. In its Complaint, the FTC also stated as follows:

35. Xactware competes more closely with EagleView than any other Rooftop Aerial Measurement Products provider. Its close existing relationships with insurance carriers enabled it to grow faster and better penetrate the market than any fringe rooftop aerial measurement competitor. Moreover, its strong presence in Claims Estimation Software provides Xactware a significant, and unique, ability to continue competing vigorously with EagleView. It also provides Xactware a strong incentive to defend against any threats of EagleView patent claims because it can expect a much larger share of roof reports flowing through its platform than can any other Rooftop Aerial Measurement Products provider. Likewise, Verisk has a strong incentive to continue developing a proprietary library of high-resolution aerial images, not only to support roof reports, but also to support other products and services for insurance carriers.

(Ex X, FTC Complaint ¶ 35, EV00032008.)

37. On June 15, 2015, Vista and EagleView Technology Corporation signed an agreement for the acquisition of EagleView by Vista (the “June 15, 2015 Agreement”). (Ex. Y, Vista-EagleView Acquisition Agreement, EV00475324 at 329, 427; Ex. O, Barrow Tr. at 4, 145:16-146:13, 149:17-150:16.)

38. The June 15, 2015 Agreement was signed on behalf of EagleView Technology Corporation by its then-CEO, Chris Barrow. (Ex. Y, Vista-EagleView Acquisition Agreement, EV00475324 at 427; Ex. O, Barrow Tr. at 4, 145:16-146:13, 149:17-150:16.)

39. [REDACTED]

[REDACTED]



(Ex. Y, Vista-EagleView Acquisition Agreement, EV00475324 at 372.)

40.



(Ex. Z, Disclosure Schedule of Vista-EagleView Acquisition Agreement, EV00476017 at 07; Ex. O, Barrow Tr. at 4, 152:7-14.)

41.



[REDACTED] (Ex. Z, Disclosure Schedule of Vista-EagleView Acquisition Agreement, EV00476017 at 045-047.)

42. Xactware's Sketch program could use an image as an underlay to sketch out a roof around 2004/2005. (Ex. P, Lewis Tr. at 17:16-25.)

43. In 2012, Xactware sought to terminate the 2008 contract with EagleView. (Ex. M, Complaint for Declaratory and Injunctive Relief, Dkt. 1 ¶ 2, *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 2:12-cv-01913 (W.D. Wash. Oct. 29, 2012).)

44. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]





[REDACTED]





[REDACTED]

[REDACTED]

[REDACTED] (Ex. U, Verisk-EagleView Acquisition Agreement, EV00775747 at 859; Ex. BB Vista-EagleView Acquisition Agreement "Exhibit A" Definitions, EV00475857 at 872, 869; Ex. O, Barrow Tr. at 4, 151:5-152:3.)

45. Plaintiff filed the instant patent infringement suit on September 23, 2015. (Dkt. 1, *Eagle View Technologies, Inc., et al. v. Xactware Solutions, Inc., et al.*, No. 1:15-cv-07025 (D.N.J.).)

46. Under the January 14, 2014 Agreement, the term “


 (Ex. U, Verisk-EagleView Acquisition Agreement, EV00775747 at 752, 848, 851, 854, 863.)

47. Under the June 15, 2015 Agreement, 


 (Ex. BB Vista-EagleView Acquisition Agreement “Exhibit A” Definitions, EV00475857 at 857, 860; Ex. Y, Vista-EagleView Acquisition Agreement, EV00475324 at 329.)

48. 

 (Ex. AA, Taylor Tr. at 251:10-253:6.)

49. With respect to [REDACTED]

[REDACTED] (Ex. AA, Taylor Tr. at 253:13-256:23.)

50. Geomni continues to make use of the things it is investing in to deliver solutions to customers and stakeholders interested in solutions. (Ex. AA, Taylor Tr. at 273:2-274:13.)

Dated: August 31, 2018

Respectfully submitted,

s/Scott S. Christie

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